

REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 27, 2005 (Part of Paper No. 20051213). Through this response, claims 1, 4, and 26 have been amended. Reconsideration and allowance of the application and pending claims are respectfully requested.

Finality of Office Action

In response to the Final Office Action, Applicants respectfully request that the Examiner enter the foregoing amendments and consider the following remarks because the claims have been placed in condition for allowance. In the alternative, Applicants request that the claims amendments be entered because they better place the claims in condition for an appeal.

Claim Rejections - 35 U.S.C. §112, First Paragraph

Claims 1, 4, and 25 remain rejected and new claims 26-33 have been rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling for the reasons of record and for the reasons set forth below. Applicants respectfully request that the rejection of these claims be withdrawn.

Applicants have amended claims 1, 4, and 26 to recite "comparing increased expression of *Wnt5a* ... to the gene expression profile of *Wnt5a* from a cluster of pair-matched tumor samples". Claim 28 recites in part the phrase: "analyzing expression of *Wnt5a* in the test sample of the tumor compared to a *Wnt5a* gene expression profile from a cluster of pair-matched tumor samples." In view of those amendments, and in view of the Examiner's indication that "the claimed methods require the mathematical analysis of gene expression in a series of samples using cluster prediction techniques" is required in the claims, it is respectfully asserted that independent claims 1, 4, 26, and 28 define the invention in the manner required by 35 U.S.C. §112. Accordingly, Applicants respectfully request that the rejections to these claims be withdrawn. The dependent claims 25 and 27-33 are allowable for at least the reason that they incorporate all of the features of their respective independent claims.

Claim Rejections - 35 U.S.C. § 102(a)

Claims 1 and 25 remain rejected and new claims 26-33 have been rejected under 35 U.S.C. § 102(a) as being anticipated by *Bittner et al.* (Nature, Vol. 406, 3 August 2000, pages 536-560). For the reasons of record and for the reasons set forth below, Applicants respectfully traverse this rejection.

(1) Pointing Out Difference Between Alleged Prior Art and Claimed Subject Matter not Necessary

The Office Action alleges the following:

Whether or not all of the inventors of the claimed invention were authors of the cited prior art is not particularly relevant to this line of reasoning as such arguments do not specifically point out any differences between the teachings of the prior art and the claimed subject matter.

Office Action at 3. Applicants respectfully traverse this line of reasoning. The fact that all inventors were also co-authors of the cited references has been point out to support the claim that the inventors invented any portion of the claimed subject matter that might be found in the cited reference prior to its publication by mere fact that they co-authored the publication before it was published.

(2) Applicants' Statements in Specification Do Not Render *Bittner* Admitted Prior Art

The Office Action states the following:

The specification teaches (page 21, line 1), "We have proposed that a discrete and previously unrecognizable cancer taxonomy can be identified by viewing the systematized data from gene expression experiments (*Bittner et al. Nature* 406:536-540, Aug. 3, 2000; incorporated herein by reference)."

According to the MPEP, where the specification identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art. In *re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA). MPEP 2129 [R-3]

Accordingly, the *Bittner et al.* reference is clearly admitted prior art by another.

Office Action at 3. Applicants respectfully traverse the Examiner's line of reasoning. First, the Examiner elected to leave out an important part of the quote from the MPEP. After the citation to *In re Nomiya*, the MPEP Section 2129 goes on to interpret that

case by stating, “(holding applicant’s labeling of two figures in the application drawings as ‘prior art’ to be an admission that what was pictured was prior art relative to applicant’s improvement)” (emphasis added).

The *Nomiya* case cited by the Examiner does not apply to instant case. From the above excerpt, it is clear that disclosed material can only be taken as admitted prior art when the applicant actually states that it is prior art. For instance, in the example provided by the *Nomiya* case cited in MPEP § 2129, figures labeled “prior art” were used as admitted prior art.

In the present case, Applicant made no admissions that the information contained in the Bittner *et al.* reference is prior art. Instead, this information was provided as “background” material to provide a context for the claims, which pertain to methods of diagnosing an aggressive form of cancer. Applicants have made no such explicit statement that the Bittner *et al.* reference is “prior art.”

In view of the foregoing, it is clear that no admission has been made by Applicants and therefore, as per MPEP 2129, Applicants’ disclosure may not be used as admitted prior art. Applicants therefore respectfully submit that the rejection is improper as for failing to disclose or render obvious one or more explicit limitations of Applicants’ claims. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

(3) Affidavit Under 1.131 was Sufficient to Overcome the Rejection

The affidavits of the inventors submitted under 37 CFR 1.131 are sufficient to overcome the rejection because the Applicants have not clearly admitted on the record that subject matter relied on in the reference is prior art. The Examiner quoted portions of MPEP 715 as providing support for the proposition that the affidavits submitted under 37 CFR 1.131 were inappropriate. However, MPEP §715.01(c) states the following:

Reference Is Publication of Applicant's Own Invention

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under 37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37 CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a

date of invention is not applicable. *Ex parte Lemieux*, 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); *Ex parte Powell*, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). ...

I. CO-AUTHORSHIP

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Clearly the portions of 715 quoted by the Examiner regarding "admitted prior art" are less applicable than the above-cited passages. As noted previously, the Bittner *et al.* reference is not admitted prior art. However, the applicants are co-authors of the publication cited against the application, which rejection may be overcome by filing an affidavit under 37 CFR 1.131.

With respect to the case law cited by the Examiner on page 4 of the Office Action, in each of the cited cases except one, the cited prior art was authored by completely different persons than the Applicants in those cases; the Applicants were not the co-authors of the alleged prior art. Thus, those cases are not applicable to the facts in the instant application where the Applicants are co-authors of the cited art. The case that is the exception, *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964), the appeals court actually reversed and remanded the case to the Board for further findings. Specifically, where Blout and Rogers were the applicants and Corley was the cited prior art reference, the CCPA held:

Blout and Rogers' affidavits, while unsatisfactory to establish an earlier reduction to practice under Rule 131, nonetheless convince us that there is no need to overcome Corley as a prior art reference. The facts established by the affidavits show that Blout, Rogers and Corley worked together for the Polaroid Corp.; that their work was contiguous and sometimes overlapping; that Blout and Rogers are claiming what they invented....

In re Blout, 333 F.2d 928, 931, 142 USPQ 173 (CCPA 1964) (emphasis added). Because Corley was a patent reference, the CCPA remanded to the Board for a

determination of double patenting, but the issue was no longer whether Corley was prior art. The *Blout* case appears to stand for the proposition that where Applicants worked with the inventor of another application, there is no need to overcome the other application as a prior art reference. Thus, in the instant case, the affidavits under Rule 131 should similarly suffice to demonstrate that the Bittner *et al.* reference is not eligible to be used as prior art. For at least this reason also, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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